

**REMARKS**

Claims 2, 7, 8, 38, 39, and 42-49 are presently pending. Claim 8 has been amended to correct a typographical error. No surrender of claimed subject matter is intended by the amendment. No new matter has been added. Reconsideration of the present application is respectfully requested in light of the arguments given below.

**35 USC § 102(e)/103(a) REJECTION OF CLAIMS 42-49**

As an initial matter, claims 42-49 stand rejected under 35 U.S.C. §102(e) over Traise '117. The Applicant respectfully traverses this rejection. Independent claim 43 recites a housing. Traise does not teach a housing, either expressly or impliedly. To anticipate a claim, the reference must teach every element of the claim. *See* MPEP 2131. The identical invention must be shown in as complete detail as is contained in the claim. *See id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Because Traise does not teach a housing, Traise can not anticipate claim Applicant's claim 43. Therefore, withdrawal of the Section 102 rejection is respectfully requested.

In the alternative, the Examiner has rejected claims 42-49 under 35 U.S.C. 103(a) over Traise '117 in view of Hartman (4,761,799) and/or Pfeiffer (4,949,606). The Applicant respectfully traverses this rejection.

The Examiner acknowledge that Traise does not disclose a housing, or the recited inlet opening and outlet opening. To correct this deficiency, the Examiner first takes Official Notice that such features are allegedly old and well known in the art. To the extent the Examiner uses Official Notice to provide either missing features or motivation to combine features, the Applicant respectfully traverses and respectfully requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP 2144.03.

Next, the Examiner proposes a combination of Traise with Hartman and/or Pfeiffer to correct the deficiencies of Traise. The Applicant respectfully submits that these references, alone or in combination, do not render Applicant's claim 3 obvious.

The Applicant respectfully submits that neither Traise nor Pfeiffer are analogous references. To rely on a reference under 35 U.S.C. 103, it must be in an analogous art. *See* MPEP 2141.01. Traise describes a machine for cutting sticky labels, not game tickets. Traise's specification itself distinguishes his device from other devices for cutting non-adhesive paper products (such as Applicant's game tickets) and indicates that the substitution between these two fields of endeavor is inappropriate. *See, e.g.*, Traise 1:10-22. Traise uses special silicone elastomer-covered rollers to avoid sticking to the label adhesive, Col. 1: 42-48, and special high friction rollers for engaging the slick surface of a label web which is designed not to stick to the sticky side of the labels when the labels are in roll form. These features are not present in game tickets. Traise does not teach or suggest the problems of dispensing game tickets that are addressed by the Applicant. Similarly, Pfeiffer does not deal with separating strips of game tickets. Rather, Pfeiffer describes cutting continuous data tapes, not tickets joined by lines of weakness. For this reason, Applicant respectfully submits that Pfeiffer is not an analogous reference.

To establish a prima facie case of obviousness, the prior art reference(s) must teach or suggest ALL the claim limitations. *See* MPEP 2143. In addition to the housing, Traise neither teaches nor suggests the inlet opening and outlet opening recited in Applicant's claim 43. Moreover, Applicant's claim 43 positively recites "a strip of tickets". Applicant respectfully submits that the labels of Traise neither teach nor suggest a strip of tickets. Rather as discussed above, Traise deals with sticky labels, a different type of product to be dispensed with different properties than some tickets. The labels dealt with in Traise are sticky on one side, and very slippery on the other side, to prevent the labels from sticking together when the labels are in a roll. Accordingly, the Traise device has a special high friction and low friction rollers which would be unsuitable for use with game tickets. Applicant also respectfully submits that the Traise device is unsuited for use with game tickets.

The next element of a prima facie case of obviousness that the Examiner is required to supply is a motivation to combine the references. The alleged motivation for the combination proposed by the Examiner is to achieve “the well known benefits including protecting the operating structure from the environment”. If the Examiner is taking official notice of this alleged motivation, the Applicant respectfully traverses and requests the Examiner cite a reference or provide an affidavit in support of the rejection. *See* MPEP 2144.03.

In any event, the Examiner has not provided a proper motivation to combine the references. To reject, the Examiner must find a suggestion to combine the references that is “clear and particular”. *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for “actual evidence” of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). The Examiner’s motivation is a hindsight reconstruction, obtained by picking and choosing elements from Applicant’s claimed invention. Applicant respectfully submits that Examiner has not met his burden of finding a motivation to combine in the cited art, and thus has not made out a prima facie case of obviousness.

Claims 42, and 44-45 depend from claim 43 and thus should be patentable over the cited references for at least the same reasons as claim 43. Claims 46, although independent, also recites a housing limitation and should be patentable over the cited references for at least similar reasons to claim 43. Claims 47-49 depend from claim 46 and thus should be patentable for at least the same reasons as claim 46.

### **35 USC § 103 REJECTION OF CLAIMS 2, 7, 8, 38 and 39**

Claims 2, 7, 8, 38 and 39 stand rejected under 35 U.S.C. 103(a) over Burr (5,222,624) in view of Bittner (5,290,033) and Traise (5,853,117).

Independent claim 7 recites a rotary dull helical separator member. None of the cited references teach or suggest a dull helical separator member. The Examiner relies on Traise to

provide this element in his proposed combination of references. As discussed above for claim 43, the Applicant respectfully submits that Traise is not analogous art and his apparatus is unsuitable for use with game tickets. Moreover, Traise does not teach the recited dull helical separator. Traise's label cutter has two embodiments, one with a sharp rotary blade, and one with a smooth breaker bar for perforated labels. The embodiment for bursting with a smooth breaker bar is not helical. Col. 5: 19-20. There is no teaching or suggestion in Traise of a dull helical separator as recited in Applicant's claim 7. Furthermore, no motivation is provided to combine the two embodiments to produce the recited dull helical separator.

Next, the Examiner relies on a combination of Burr and Bittner to supply detector means and credit means. The Examiner took Official notice that detector means as recited in Applicant's claim 7 are "old and well-known in the art". Applicant respectfully traverses, and requests either a reference cited with a proper motivation to combine or an affidavit. *See* MPEP 2144.03.

To the extent the Examiner is combining Bittner with Burr, the Applicant traverses and submits that the Examiner is engaged in hindsight reconstruction. The combination of Burr with Bittner is taught by neither reference. Bittner is a dispenser for pull-tab tickets dispensed from packs of separate tickets while Burr deals with tickets on continuous strips. The Examiner has given no proper motivation to combine these references, instead relying on a hindsight reconstruction. Moreover, to the extent the combination arguably were proper, the Burr and Bittner references involve both games and ticket dispensers with fundamentally different principles of operation - separated pull-tab tickets and scratch-offs in continuous strips. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See* MPEP 2243.01 (citing *In re Ratti*, 270 F.2d 810 (CCPA 1959)). Accordingly, the Applicant respectfully withdrawal of the rejection based on the proposed combination of Bittner and Burr.

Independent claim 8 recites the currency acceptor and credit display similar to claim 7, and thus should be patentable for at least the reasons given above for claim 7. Claim 8 also

recites both a housing for storing a plurality of different types of game tickets and a drive housing as part of the separator drive module. Applicant respectfully submits that the cited references do not teach or suggest this recited claim feature.

Claim 2, which depends from claim 8, should be patentable for at least all the reasons given above for claim 8. Moreover, claim 2 further recites that the ticket types include instant-winner pull-tab tickets stored in stacks of separate tickets. Applicant respectfully submits that none of the cited references teach or suggest a ticket dispenser that dispenses both from stacks of separate tickets and from tickets stored in strips. The Examiner takes Official Notice that such tickets are old and well known, and proposes a combination based on “well known benefits”. Applicant respectfully traverses the official notice and requests an affidavit or reference. *See* MPEP 2144.03. Moreover, Applicant emphasize that none of the cited reference teach or suggest a machine that provides both types of tickets. The Examiner’s proposed combination is a pure hindsight reconstruction, as none of the cited references teach such a combination is desirable or even possible.

Independent claim 39 recites a multi-game ticket self-service terminal having a housing. The terminal includes a dispensing means having a drive housing. This claim should be allowable for reasons similar to those given above for claims 8 and 43. Claim 38 depends from claim 39 and recites that the ticket types include instant-winner pull-tab tickets stored in stacks of separate tickets. Claim 38 should thus be allowable for additional reasons similar to those given above for claim 2.

### **CONCLUSION**


The claimed invention is new, non-obvious and useful. All reasons for rejection having been obviated, withdrawal of the rejections and prompt passage to allowance is respectfully requested.

Appl. No. 09/385,336  
Att. Docket No. 12406/93  
Reply To Non-Final Office Action of 11/21/03

The Examiner is invited to telephone the undersigned attorney to discuss the amendments or any questions about the enclosed arguments.

Respectfully submitted,  
KENYON & KENYON

Dated: Feb. 23, 2004

By:   
Andrew L. Reibman  
(Reg. No. 47,893)

One Broadway  
New York, NY 10004-1050  
Ph: 212-425-7200  
Fax: 212-425-5288

**CUSTOMER NO. 26646**